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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

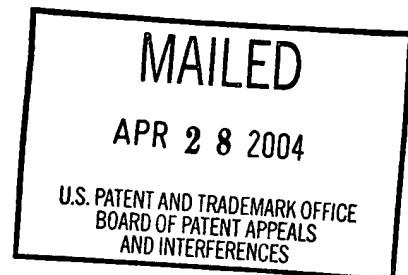
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER J. WILK

Appeal No. 2003-0101
Application No. 09/661,520

ON BRIEF



Before HAIRSTON, KRASS and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-18.

The invention is directed to a novelty item. In particular, a sea shell, or an item made to look like a sea shell, is outfitted with a sound reproduction device and a proximity detector within, such that when a user lifts the sea shell to his/her ear, expecting to hear the sound of the ocean, in

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accordance with lore, what is heard is a digitally encoded artificial sound which could be, for example, the roar of a lion, or a recorded spoken message such as, "Get your ear out of my house."

Representative independent claim 1 is reproduced as follows:

1. A novelty or entertainment device comprising:
 - a housing in the form of a sea shell;
 - a sound reproduction system mounted to said housing so as to remain hidden from casual visual inspection of said housing; and
 - a switch mounted to said housing and operatively connected to said sound reproduction system for activating same after and only after a lifting of said housing to an ear of a user.

The examiner relies on the following references:

Curran	4,923,428	May 08, 1990
Saitoh	5,316,516	May 31, 1994

Claims 1-18 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Saitoh with regard to claims 1-5, 7-12 and 14-16, adding Curran with regard to claims 6, 13, 17 and 18.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

We REVERSE.

Each and every one of the instant claims requires at least a housing in the form of a sea shell and some actuation of a sound reproduction device when the housing is lifted to the ear of a user.

Saitoh is directed to the actuation of a toy bird, so that an animated singing toy bird results from an external stimulus such as body heat of a user approaching the toy bird. Not only is Saitoh devoid of any teaching or suggestion of a housing in the shape of a sea shell, but the toy bird of Saitoh becomes animated and reproduces sound (viz., of a singing bird) upon the approach of a user rather than upon the device being lifted.

The examiner contends that the difference in shape of the housings in Saitoh and the instant claimed invention is a "matter of design choice" (answer-page 3). We disagree. The shape of the housing in the instant claimed invention is more than a design choice. It is the shape of a sea shell which encourages a user to pick up the device and place the device next to his/her ear, wherein the novelty of the device, i.e., the surprise of

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hearing something other than the expected ocean sound, is realized. There would have been no reason for the artisan to modify the shape of the device in Saitoh to make it look like a sea shell.

Regarding the type of sensor employed, the examiner contends that different types of switches are "merely alternative forms of a sensor" (answer-page 4) and that since one sensor "does not appear to have any significant advantage over the others" (answer-page 4), it would have been obvious to modify the sensor 44 of Saitoh with any equivalent sensor. Again, we disagree. Since the sensor employed by the instant claimed invention permits the sound reproduction device to be activated upon lifting of the device, as compared with Saitoh's sensor which is also a proximity sensor but does not respond to lifting of the device, it is clear that one type of sensor does, indeed, have an advantage over other types of sensors. The examiner has presented no convincing rationale that would have led the artisan to employ a sensor in Saitoh's toy bird which would activate the sound reproduction mechanism upon lifting of the toy bird.

As such, it is clear to us that the examiner has not presented a prima facie case of obviousness with regard to the subject matter of claims 1-5, 7-12 and 14-16 and we will not

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sustain the rejection of these claims under 35 U.S.C. § 103.

With regard to claims 6, 13, 17 and 18, the examiner adds Curran for the teaching of an interactive talking toy having a sound reproduction system with a memory for storing a plurality of different sounds.

However, Curran clearly does not remedy the deficiencies of Saitoh, as noted supra. Therefore, we also will not sustain the rejection of claims 6, 13, 17 and 18 under 35 U.S.C. § 103.

We note in passing that certain of the instant claims, e.g., claim 1, appear to be misdescriptive in the recitation of activating the sound reproduction system after "and only after" a lifting of the housing "to an ear of a user." It would appear that the sound reproduction system would be activated just as well if the user lifts the housing to a knee, or an elbow, or any other body part, or structure, so it is unclear why the system is activated "after and only after" lifting to an "ear." We leave it to the examiner and/or appellant to make any amendments deemed necessary.

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The examiner's decision rejecting claims 1-18 under
35 U.S.C. § 103 is reversed.

REVERSED


KENNETH W. HIRSTON

Administrative Patent Judge


ERROL A. KRASS

Administrative Patent Judge

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APPEALS AND
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JERRY SMITH

Administrative Patent Judge

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